

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q94746

Frederick W. HARTNER, et al.

Appln. No.: 10/578,476

Group Art Unit: 1625

Confirmation No.: 8989

Examiner: Unknown

Filed: November 17, 2006

For: PROCESSES FOR PREPARING BICYCLO [3.1.0] HEXANE DERIVATIVES, AND
INTERMEDIATES THERETO

REQUEST FOR CORRECTED OFFICIAL FILING RECEIPT

ATTN: Office of Initial Patent Examination
Filing Receipt Correction
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

We enclose a copy of the Official Filing Receipt for the above-identified application and request the following corrections:

Assignment for Published Patent Application Taisho Pharmaceutical Co., Ltd.

Verification for the requested corrections is indicated on the Assignment and Agreement filed November 17, 2006.

Respectfully submitted,



Susan J. Mack
Registration No. 30,951

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: May 11, 2007



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
www.uspto.gov

APPL NO.	FILING OR 371 (C) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/578,476	11/17/2006	1625	3530	Q94746	2	36	13

23373
 SUGHRUE MION, PLLC
 2100 PENNSYLVANIA AVENUE, N.W.
 SUITE 800
 WASHINGTON, DC 20037

RECEIVED

CONFIRMATION NO. 8989

FILING RECEIPT



OC000000022372968

MAR - 2 2007

Date Mailed: 02/27/2007

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Frederick W. Hartner, Rahway, NJ;
 Lushi Tan, Rahway, NJ;
 Nobuyoshi Yasuda, Rahway, NJ;
 Naoki Yoshikawa, Rahway, NJ;

ASSIGNMENT FOR PUBLISHED PATENT APPLICATION TAISHO PHARMACEUTICAL CO., LTD.

Power of Attorney: The patent practitioners associated with Customer Number 23373.

Domestic Priority data as claimed by applicant

This application is a 371 of PCT/US04/36574 11/03/2004
 which claims benefit of 60/518,391 11/07/2003

Foreign Applications

If Required, Foreign Filing License Granted: 02/06/2007

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US10/578,476**

Projected Publication Date: 05/17/2007

Non-Publication Request: No

Early Publication Request: No

Title

Processes for preparing bicyclo [3.1.0] hexane derivatives, and intermediates thereto

Preliminary Class

514

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process simplifies the filing of patent applications on the same invention in member countries, but does not result in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

**LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15**

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

ASSIGNMENT AND AGREEMENT

WHEREAS Merck & Co., Inc., a corporation organized and existing under the laws of the State of New Jersey, having an address at One Merck Drive, P.O. Box 100, Whitehouse Station, New Jersey 08889-0100 (hereinafter referred to as "MERCK"), by virtue of

- (1) an assignment dated October 19, 2004, between Frederick W. Hartner, Naoki Yoshikawa and Lushi Tan, and MERCK; and
- (2) an assignment dated November 4, 2004 between Nobuyoshi Yasuda and MERCK;

(copies of which are attached hereto), is owner of all right, title and interest, for all countries, in and to certain inventions relating to "Processes for Preparing Bicyclo [3.1.0] Hexane Derivatives, and Intermediates Thereto," described in the following applications for patent:

- (1) MERCK Case 21395PV, U.S. Provisional Patent Application Serial No. 60/518,391, filed November 7, 2003;
- (2) MERCK Case 21395Y, International Patent Application No. PCT/US2004/036574, filed November 3, 2004; and
- (3) Taiwan Patent Application No. 093133900, filed November 5, 2004;

(hereinafter "said inventions"), including any and all benefits under the International Convention for the Protection of Industrial Property and related treaties, and under any and all Letters Patent which may be granted therefor, and under any and all extensions, divisionals, reissues and continuations of said applications for patent, including any applications equivalent thereto or claiming priority thereof,

AND WHEREAS Taisho Pharmaceutical Co., Ltd., a company organized and existing under the laws of Japan, having its head office at 24-1, Takada-3-chome, Toshima-ku, Tokyo 170-8633, Japan (hereinafter referred to as "TAISHO"), wishes to acquire all right, title and interest in said inventions,

NOW THEREFORE, pursuant to the "License Agreement by and between Taisho Pharmaceutical Co., Ltd. And Merck & Co., Inc., effective as of May 15, 2002," (hereinafter referred to as "License Agreement") and the "Termination Agreement", effective as of September 30, 2005 (hereinafter referred to as "Termination Agreement"), and for value received, MERCK hereby sells, assigns, transfers and sets over to TAISHO and its successors, assignees and legal representatives, MERCK's entire right, title and interest, for all countries, in

and to said inventions, and any and all present patent applications or future patent applications to said inventions that may be filed in any country, including any and all extensions, divisionals, reissues and continuations of said applications for patent, including any applications equivalent thereto or claiming priority thereof; all of the above to be held and enjoyed by TAISHO for its own use and enjoyment to the full end of the term or terms for which such Letters Patent and related intellectual property rights may be granted, as fully and entirely as the same would have been held and enjoyed by MERCK had this assignment and sale to TAISHO not been made.

MERCK requests that any and all Letters Patent for said inventions be issued to TAISHO, its successors, assignees and legal representatives, or to such nominees as it may designate.

MERCK further covenants that TAISHO will, upon its request, be provided promptly with all pertinent facts and documents relating to said inventions and the Letters Patent and legal equivalents as may be known and accessible to MERCK, and that it will assist in any interference, litigation or proceeding related thereto and agrees that, when requested, it will promptly execute and deliver to TAISHO or its legal representatives any and all papers, instruments or affidavits required to apply for, obtain, maintain, issue and enforce said applications, and the Letters Patent and equivalents thereof which may be necessary or desirable to carry out the purposes thereof.

MERCK further covenants that it shall not request TAISHO to give MERCK any further consideration for this assignment and sale, whatsoever, other than all consideration received by MERCK under the License Agreement and Termination Agreement.

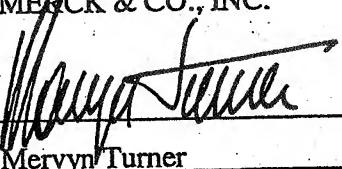
MERCK further covenants with TAISHO, its successors, assigns and legal representatives, that the rights and property herein conveyed are free and clear of any encumbrance, and that it has full right to convey the same as herein expressed.

This assignment may be executed in two or more counterparts, each of which shall be deemed an original, but all of which together shall constitute one and the same instrument.

IN WITNESS WHEREOF, this Assignment and Agreement is executed by duly authorized representatives of MERCK and TAISHO as of the effective date set forth below.

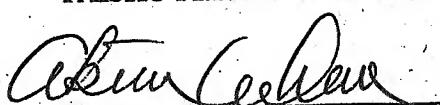
Signed at Rahway, N.J.
this 27 day of March, 2006.

MERCK & CO., INC.

By: 
Name: Mervyn Turner
Title: Senior Vice President, Worldwide Licensing and External Research

Signed at Tokyo, Japan
this 5th day of April, 2006.

TAISHO PHARMACEUTICAL CO., LTD.

By: 
Name: Akira Uehara
Title: President

Attorney Docket Number 21395Y

U.S. Serial No. _____

ASSIGNMENT AND AGREEMENT

Filing Date _____

For value received, we, Frederick W. Hartner, Lushi Tan, Nobuyoshi Yasuda and Naoki Yoshikawa

of 656 Elliot Court, Somerville, NJ 08876;
11 Bernice Street, Edison, NJ 08820;
225 Oak Tree Road, Mountainside, NJ 07092; and
43 Burnside Avenue, Cranford, NJ 07016, respectfully

hereby sell, assign and transfer to MERCK & CO., Inc., a corporation of the State of New Jersey, having an office at Lincoln Avenue,
City of Rahway, State of New Jersey, and its successors, assigns and legal representatives, our entire right, title and interest, for all
countries, in and to certain inventions relating to

PROCESSES FOR PREPARING BICYCLO [3.1.0] HEXANE DERIVATIVES, AND INTERMEDIATES THERETO

described in an application for Patents having Attorney Docket Number 21395Y and in application(s) Serial No. 60/518,391
filed on 11/07/2003 ; Serial No. filed on ; Serial No. filed on (if applicable),

and all our rights and privileges, including any and all benefits under the International Convention for the Protection of Industrial Property, under any and all Patents which may be granted therefor, and under any and all extensions, divisionals, reissues and continuations of said application for Patents, including any foreign applications derived therefrom, equivalent thereto or claiming priority thereof.

We request that any and all Patents for said inventions be issued to said assignee, its successor, assigns and legal representatives, or to such nominees as it may designate.

We agree that, when requested, we will, without charge to said assignee but at its expense, sign all papers, take all rightful oaths, and do all acts which may be necessary, desirable or convenient for securing and maintaining Patents for said inventions in any and all countries and for vesting title thereto in said assignee, its successors, assigns and legal representatives or nominees.

We covenant with said assignee, its successors, assigns and legal representatives, that the rights and property herein conveyed are free and clear of any encumbrance, and that we have full right to convey the same as herein expressed.

We hereby authorize our attorney, John C. Todaro or an attorney with Power of Attorney in this application, of the said MERCK & CO., Inc., to insert Serial No., (s) and Filing Date(s) of said application(s) when known.

Signed at Rahway, New Jersey this 19th day of October, 2004.

Frederick W. Hartner
Frederick W. Hartner

Lushi Tan
Lushi Tan

Naoki Yoshikawa
Naoki Yoshikawa

Attorney Docket Number 21395Y

U.S. Serial No. _____

Filing Date _____

ASSIGNMENT AND AGREEMENT

STATE OF NEW JERSEYCounty of UNION

SS.

Personally appeared before me the above-named Frederick W. Hartner Naoki Yoshikawa Lushi Tan

to me known and known to me to be the person(s) who executed the foregoing instrument and acknowledged said instrument to be
their free act and deed this 10th day of October, 2004.

Karen Ann Drost

KAREN ANN DROST
NOTARY PUBLIC OF NEW JERSEY
Commission Expires 10/22/2008Signed at Rutherford, New Jersey this 4th day of November, 2004.

Nobuyoshi Yasuda

County of Union

SS.

Personally appeared before me the above-named Nobuyoshi Yasuda

to me known and known to me to be the person(s) who executed the foregoing instrument and acknowledged said instrument to be
their free act and deed this 4th day of November, 2004.

KAREN ANN DROST
NOTARY PUBLIC OF NEW JERSEY
Commission Expires 10/22/2008

Notary Public